UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,948	01/11/2007	Christian M. Stich	1034193-000051	8426

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EXAMINER
LEE, MARINA

ART UNIT	PAPER NUMBER
2192	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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	Application No.	Applicant(s)
Office Action Summary	10/574,948	STICH ET AL.
	Examiner	Art Unit	
	MARINA LEE	2192	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _27 December 2010_.
2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-16_ is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) _1-16_ is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a) ☐ All   b) ☐ Some * c) ☐ None of:
      1. ☐ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____.
      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   Applicants' amendment and response dated December 27, 2010 in responding to the Office Action of September 24, 2010 provided in the rejection of all pending claims 1-16.

Claims 1, 4, 6, 9, and 15 have been amended.

No claims have been added nor cancelled.

Thus, claims 1-16 are pending and are presented for examination.

2.   Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Prior Art's Arguments – Rejections

3.   Applicant's arguments filed on December 27, 2010 with respect to amended claim limitations, "… wherein the system planning tool comprises a

user interface, a planning logic unit, a data management unit, and a planning

database, in which the user interface transmits selected system options to the

planning logic unit and to the data management unit, the planning logic unit uses

a data …installation steps for transmitting functionalities stored in the installation,

verification and/or configuration files of the software packages to system

components", are currently recited in claims 1 and 6, have been fully considered

but they are moot in view of new ground (s) rejections as will further be

addressed under the *Claim Rejections below.*

In re to the previous 35 USC 101 rejection of system claim 1, Applicants

allege that,

"For clarification, Applicants' claim 1 is amended to recite a system for
automatically installing, verifying and configuring functionalities, stored in
installation, verification and/or configuration files, for system components
connected in a distributed network, wherein the system comprises "a system
planning tool for creating, checking and configuring the installation, verification
and/or configuration files for respective system components that are network
nodes in the distributed network," and "the system components, when
configured, form the system. According to Applicants' claim 1, the system
transforms the system components that are network nodes in the distributed
network by installing, verifying and configuring functionalities in them.
Accordingly, the claimed system is directed to statutory subject matter." – *See
Remarks, page 8 last paragraph and page 9 first paragraph, which examiner
respectfully disagrees.*

As to claim 1, it is merely recites to include, "A <u>system</u> for

automatically…where <u>the system comprises</u>: a <u>system planning tool for</u>

…wherein the system planning tool includes: a user interface for transmitting…

the planning logic … and the data management unit and the <u>system component</u>

<u>for</u> … <u>such that</u> … <u>when</u> configured, <u>form</u> the system" does not comprise

hardware component (no physical transformation) in order to realize the

functionality of the system. The "system" without such hardware component may be broadly interpreted as data structures representing descriptive material per ser or computer programming representing computer listing per ser – functional descriptive material under 35 USC § 101. See MPEP 2106.01(I).

Furthermore, the amended limitation, "…for respective system components that are network node in the distribute network" and "the system component for automatically checking and configuring specified installation … such that the system components, when configured, form the system" with emphasis added.

As can be seen with underline from above, the claim limitation "for" and "such that... when configured..." are intentional use and does not imply that "system" comprise any hardware as note above. Thus, Applicants argument is no persuasive.

Claim Rejections - 35 USC § 101

4.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5.   Claims 1-5 and 11-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As to claim 1, recites to include, "A system for automatically…where the system comprises: a system planning tool for …wherein the system planning tool includes: a user interface for transmitting… the planning logic … and the data management unit and the system component for … such that … when

configured, <u>form</u> the system" does not comprise any hardware component (no

physical transformation) in order *to realize the functionality* of the system. The

"system" without such hardware component may be broadly interpreted as data

structures representing descriptive material per ser or computer programming

representing computer listing per ser – functional descriptive material under 35

USC § 101. See MPEP 2106.01(I).

Claims 2-5 and 11-13 recite the limitations that do not cure the deficiency

of the base claim 1, which regarding to the rejection of non-statutory under 35

USC 101. Therefore, they are also rejected for the same reason.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as
> set forth in section 102 of this title, if the differences between the subject matter sought to be
> patented and the prior art are such that the subject matter as a whole would have been obvious at
> the time the invention was made to a person having ordinary skill in the art to which said subject
> matter pertains. Patentability shall not be negatived by the manner in which the invention was
> made.

7.   Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Bourke-Dunphy et al. (US 2002/0133814 A1 made of record, hereinafter

Bourke-Dunphy) in view of Hellerstein et al. (US 2002/0129356 A1 made of

record, hereinafter Hellerstein).

As per claims 1 and 6, Bourke-Dunphy discloses a method for

automatically installing and configuring functionalities, stored in installation,

verification and/or configuration files, for system components arranged in a

distributed network, where

a system planning tool is used to create, check and configure the

installation, verification and/or configuration files for the respective system

components – *(e.g. system and method 10 of Fig. 1 for planning an installation*

procedure to a plurality of application and/or service components on which

computer or computers each selected component is to be installed – see at least

[0005], [0007], and [0022]),

wherein the system planning tool comprises a user interface , a

data management unit, and a planning database -- (*e.g. system 10 of fig. 1 – see*

at least [0023]), in which

the user interface transmits selected system options to the planning logic

unit and to the data management unit – *(e.g. the identified components is*

selected for installation on one or more components via user interface such as

user interface 12 of Fig. 1, wherein an installation procedure is determined based

on dependency requirement for the components that are selected for installation

– see at least [0007],[0023], [0031], [0054], [0075] with emphasis added.),

the planning logic unit uses a data and rule manager integrated in the data

management unit to produce installation, verification and/or configuration plans

from the system options, the installation, verification and/or configuration plans

for further processing in the data management unit – (*e.g. the user interface 12 is*

operatively associated with a dependency engine 14 for determining whether the

component selections violate any dependency rules dependency data 16 – see

at least [0007], [0008],[0058]-[0059], and[0076-0077] with emphasis added) , and

the installation, verification and/or configuration files specified in the respective

system components are automatically installed, checked and configured in the

respective system component in a prescribed order and manner, and

the system components are configured to form an overall system - *(e.g.*

install software to select computers in an order within common network domain

See at least [0079-0080] with emphasis added).

It is to note that , while Bourke-Dunphy discloses the data management

unit uses an integrated data generator to generate and configure – (*e.g.*

generating installation procedure 18 – see at least [0026]) but does not explicitly

disclose the data management unit uses an integrated data generator to

generate and configure *software packages* that are dependent on each other, the

software packages comprising installation, verification and/or configuration files

from the system options in the user interface, system information stored in the

planning database, and the installation, verification and/or configuration plans

produced by the planning logic unit, and ascertains installation steps for

transmitting functionalities stored in the installation, verification and/or

configuration files of the software packages to system components; However,

Hellerstein, in an analogous art, discloses,

"Computer-based methods and systems for performing <u>automated
distribution of a software package</u> to <u>one or more target machines</u> in one or more
regions of a <u>distributed network of target machines</u>, comprises the following
steps. First, a base <u>software package</u> is prepared for each of the one or more
regions based on at least one of: (i) policy data indicating which of the one or
more regions are candidates for receiving the software package, (ii) dependency
information <u>indicating requisites for a service provided by the software package,
and (iii) configuration information for each of the candidate regions</u>. The base
software package is then distributed to each of the candidate regions of the

distributed network. The base software package received at each of the candidate regions is then customized based on at least one of: (i) regional distribution policies, (ii) dependency information specific to one or more roles performed by the target machines in that region, and (iii) individual target machine configuration information. Lastly, the software package customized in each of the candidate regions is distributed to at least one of the target machines in the candidate regions of the distributed network. …the basic service (software) package 504 is the component that is a candidate for installation in the appropriate target machines…when a region server, responsible for distributing a package to each of the end points within its domain, receives a base service package 522, it needs to augment it with specific dependency items that are needed by the individual machines within the region. This is done by a region package augmentor operation 520, which receives as input the regional distribution policies 528, the dependency information 524 specific to the machines in that region, and individual machine configuration information 526 that will be used to customize the base package for each of the target machines. The output is a set of customized packages 530 that is produced for each group of machines within the region, having the same installation environment. --*See Hellerstein, at least Abstract, [0052], and [0053] with emphasis added.*

Thus, it would have been obvious to one ordinary skill in the art at the time invention was made to use customized package preparation of Hellerstein in installation procedure 18 of *planning an installation system of* Bourke-Dunphy for automatically installation of the customized package to one or more computer within distribution network and ease the burden of installation from administrator or user as seen in Hellerstein (e.g. [0005] and [0010]).

Further regarding to claim 1, Bourke-Dunphy discloses a system – *(e.g. computer 302 of Fig. 7 and [0072])* for automatically implementing method as of claim 1 above.

As per claims 2 and 7, modified Bourke-Dunphy with Hellerstein discloses wherein following the configuration of the system components and operational overall system is formed – *See Bourke-Dunphy, at least [0074].*

As per claims 3, 8, 11, and 14, modified Bourke-Dunphy with Hellerstein discloses wherein the functionalities stored in installation, verification and/or configuration files are in the form of software packages – (e.g., customized packages 530-- *See Hellerstein, at least, [0053] and Fig. 5B, with emphasis added.*

As per claims 4, 9, 12, and 15, modified Bourke-Dunphy with Hellerstein discloses wherein the overall system is in the form of a distributed network – *(e.g. indentified computers interconnected within a common network – see Bourke-Dunphy at least, [0074])*.

As per claims 5, 10, 13, and 16, modified Bourke-Dunphy with Hellerstein discloses wherein the software packages are used to store system component data and setup data for the system components -- (*e.g. individual machine configuration information 526 used to customize the base package for each of the target machines that are output a set of customized packages 530-- See Hellerstein, at least Abstract, [0052], and [0053] with emphasis added*).

Conclusion

8.   The prior art of record and not relied upon (cited on 892 form) is considered pertinent to applicant disclosure.

9.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lee whose telephone number is (571) 270-1648. The examiner can normally be reached on M-F (9am-6: 30pm) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (571) 272-3695. The

fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. L./
Examiner, Art Unit 2192

/Tuan Q. Dam/
Supervisory Patent Examiner, Art Unit 2192